



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/157,998	09/22/98	LESSER	R

J. MARK HOLLAND  
PROFESSIONAL LAW CORPORATION  
3 CIVIC PLAZA, SUITE 210  
NEWPORT BEACH CA 92660

TM11/0802

EXAMINER

ROMAIN, J

ART UNIT

2163

PAPER NUMBER

18

DATE MAILED: 08/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/157,998

Applicant(s)

Lesser

Examiner

Romain Jeanty

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 21, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-90 is/are pending in the application.
- 4a) Of the above, claim(s) 74-76, 83, 86, 87, and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-73, 77-82, 84, 85, 88, and 89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 2163

### **DETAILED ACTION**

#### **Continued Prosecution Application**

1. The request filed on March 26, 2001 for a Request Continued Examination (RCE) under 37 CFR 1.53(d) is acceptable and a RCE has been established. An action on the RCE follows.

#### **Restriction/Election**

2. Applicant's election of Group I in Office action of Paper No. 15 (Claims 49-73, 76-82, 84-85, and 88-89) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a).

Applicant notes that Claims 40-64 appear to read upon both Group I and Group II and the restriction of claims 68-73, 75, 76, 79 and 80. Examiner agrees that Group I and Group IV contain similar subject matter and will consider both group I and Group II as one individual grouping, and claims 68-73, 75, 76, 79 and 80 will also be considered.

#### **Remarks**

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312.

To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Applicant originally filed claims 1-13. On a later amendment filed on 1/26/99, claims 1-13 were to be canceled and newly claims 1-9 were filed in place of originally filed claims 1-13. Accordingly, newly then added claims 1-9 should have been relabelled as respective claims 14-22. In the amendment dated 7/10/00, Applicant amended claims 1-9 (which should have been numbered as 14-22, as noted above) and also added claims 10-35. According to CFR 1.126, those claims 10-35 were renumbered as respective claims 23-48. Accordingly, claims 14-22 (which were filed as Claims 1-9, as mentioned above) and 23-48 (which were filed as Claims 10-35) were pending in the instant application. In its Amendment filed March 26, 2001, Applicant added Claims 49-90. In Paper No. 15, the Examiner suggested that those claims should have been renumbered as Claims 40-81. Based on that renumbering, Applicant responded (in a May 18, 2001 filing) to the Examiner's election requirement by electing at least Claims 40-64, 68-73, 75, 76, 79, and 80, based on the Examiner's renumbering to Claims 40-81. Upon reconsideration, the Examiner has changed back the numbering of the pending claims, from 40-81 to 49-90. Consequently, the elected claims (under the 49-90 numbering scheme) all "bump up" by 9. By way of reference, the resulting numbering coincides with that used in Applicant's March 26, 2001 amendment. As a result, the pending, elected claims are now Claims 49-73, 77-82, 84, 85, 88, and 89.

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 49, 54, and 88 are rejected under 35 USC 102(b) as being anticipated over Dorne (US 5,325,293).

As per claims 49 and 88, Dorne discloses a method for correlating billing codes with performed medical procedures comprising the steps of:

Electronic means to repeatedly prompt for various information and record that information (col. 5, lines 5-17 ), processing means for calculating intermediate values based on said recorded information, and for using said intermediate values to generate said billing code (col. 19, lines 23-36 ).

As per claim 54, Dorne discloses the method of claim 42 in which the step of calculating a billing code calculates an appropriate code from the United States Health Care Financing (col. 1, lines 15-30).

6. Claims 57-62, 64-68, 70-73, 79 and 87 are rejected under 35 U.S.C. 102(e) as being anticipated by Kraftson et al. (6,151,581).

As per claims 57, 58, and 87, Kraftson discloses a system and method for collecting patients data comprising:

means for prompting an interviewer (physician) to make a series of inquiries, said means optionally using at least some of the preceding responses in calculating further prompting for inquiries to make of a patient (col. 6, line 63 through col . 6, line 18; col. 9, line 16 through col. 10, line 24; see table 1A and 1B in column 12);

means for recording the patient's responses regarding the prompt inquiry (col. 6, lines col. 12, lines 63-67 and col. 5, lines 19-24);

means for calculating the billing code based on the information recorded from the medical interview (col. 10, line 46-54).

As per claims 59, 60, 64, and 65, Kraftson discloses means (handheld device) for prompting the medical practitioner regarding data to be obtained from the patient care and corresponding HCFA billing codes (col. 6, lines 19-25, lines 53-61), means for storing (database)

said data (col. 7, lines 7-11), a menu section comprising medical decision making questions (col. 9, line 66 through col. 10, line 13), payer mandated requirement “ICD-9 codes” (Col. 10, lines 46-54), scores based in part on results from responses to said menu sections (col. 15, lines 26-43), algorithm for linking and processing said requirement codes with said scores and resultant code based in part on said linked and processed requirement codes and scores (col. 8, lines 9-22).

As per claim 61, Kraftson further discloses collecting the data in real time. It thus inherent in the Kraftson system that a timer be used for timing said data gathering session.

As per claim 62, Kraftson further discloses a software for enabling a user of said apparatus to self-generate questions in any particular order (col. 21, lines 15-24).

As per claims 66 and 67, Kraftson comprises means for entering data and/or free text information on forms by an input means of a computer system (col. 14, lines 16-45).

As per claim 68, Kraftson discloses a means for displaying topics of inquiry for use with a patient during a patient encounter (col. 5, lines 12-16), data forms (electronic form) for collecting and storing data from said patient encounter, said data comprising patient responses and user generated text information in part on said patient encounter (col. 18, lines 59 through col. 19, line 41), code (management code) representatives of at least one billing procedure, and documentation requirements (col. 6, lines 36-56), algorithm for linking, comparing, and computing said collected data with said requirements (col. 7, line 61 through col. 8, line 8), resultant codes based in part on said linked, compared, and computed data (col. 14, lines 6-14), and printing means for gathered information (col. 5, lines 7-22 and col. 19, lines 33-41).

As per claim 70, Kraftson discloses a management a resultant and management code in a claim and for submitting to a payer “insurance provider”(col. 11, lines 24-35).

As per claims 71 and 72, Kraftson discloses Health Care Financing Administration, and insurance codes (col. 10, lines 40-54).

As per claim 73, Kraftson discloses a handheld device (col. 6, lines 19-31).

As per claim 79, Kraftson discloses a scannable form for prompting inquiries (col. 5, lines 1-6).

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 50-53, 56, 63, 77-78, 80 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorne (US 5,325,293) in view of Kraftson et al. (6,151,581).

As per claims 50, 53, 56, and 77-78, Dorne does not explicitly disclose an electronic means comprising a handheld computer with a touch screen interface. Kraftson et al on the other hand, discloses a system for processing patient clinical information comprising a handheld computer having a touch screen interface (col. 6, lines 19-31). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Dorne by including a handheld computer such as a lap top as evidenced by Kraftson et al. In so doing would enable Dorne to upload his information to a host or remote computer.

As per claims 51, 52, 55 and 89, Dorne discloses providing an electronic computer to prompt an information gatherer to gather information that is potentially relevant to calculating the billing code, obtaining and recording information (col. 5, lines 5-17), and electronically calculating a desired billing code from said gathered data (col. 19, lines 23-36), but Dorne does not explicitly disclose repeating said prompting, obtaining, and recording step. Official Notice is taken that it would have been obvious to a person of ordinary skill in the art to repeat these steps for obtaining

as much accurate data as possible from a patient, thereby making it easier to complete the information gathering.

As per claim 63, Kraftson does not explicitly disclose option for noting dictation and for later appending dictated notes with said responses. It would have been obvious to a person of ordinary skill in the art to include option for noting dictation and for later appending dictated notes with said responses into the system of Kraftson for the motivation of backing up of important notes taken by a physician in the case a problem occurs.

As per claim 80, Kraftson further discloses a scanner (col. 5, lines 1-6) for facilitating scannable form for prompting inquiries.

9. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraftson (6151581) in view of Letzt et al ( 5612869).

As per claim 71, Kraftson does not explicitly disclose a timer for tracking total time and patient counseling time during said patient encounter, and an algorithm for computing when said time exceeds fifty percent of said total time. Letzt discloses an electronic health care compliance assistance comprising a timer for tracking total time and patient counseling time including a Health Care Financial Administration billing code (col. 26, lines 12-28). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include total time and patient counseling time during a patient counseling into Kraftson as evidenced by Letzt. In doing so would decrease the costs to certain therapies, thereby improving compensation from the patient's insurance.

10. Claim 81, 82, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorne (US 5,325,293) in view of Letzt et al ( 5,612869).

As per claim 81, 82 and 84, Dorne does not explicitly disclose a billing code based in part on comparing a total patient encounter time and a total patient counseling time. Letzt on the other hand, discloses an electronic health care compliance assistance comprising a timer for tracking total time and patient counseling time including a health care financial administration



billing code (col. 26, lines 12-28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Dorne by including a billing code based in part on comparing a total patient encounter time and a total patient counseling time as evidenced by Letzt. The motivation being to decrease the costs to certain therapies given to a patient, thereby improving compensation from the patient's insurance.

As per claim 85, Dorne discloses an interactive program preferably also has the capability of keeping track of the ICD-9 diagnostic codes most likely associated with the procedures selected by a user (col. 16, lines 9-19).

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. (5,704,371) issued to Shepard, discloses a medical history documentation system and method.
- b. (5,964,700) issued to Tallman et al, discloses medical network management system.
- c. (6,026,363) issued to Shepard, discloses a medical history documentation system and method.
- d. (6,223,164) issued to Seare et, discloses a method and system for analyzing historical medical provider billings to establish a normative utilization profile.

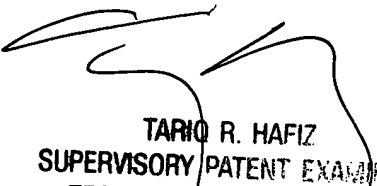
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 7:30 am to 4:30 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R. Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

July 20, 2001.



TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100